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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/022,716 | 12/18/2001 | Ann Kerstin Birgitta Kjellqvist | ACO2844 US | 2119 |

7590 01/30/2004
Joan M. McGillicuddy
AKZO NOBEL INC.
7 Livingstone Avenue
Dobbs Ferry, NY 10522

EXAMINER

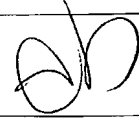
FLETCHER III, WILLIAM P

| ART UNIT | PAPER NUMBER |
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1762

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--|---|--|
| Office Action Summary | Application No. 10/022,716 | Applicant(s) KJELLQVIST ET AL.  | |
| | Examiner William P. Fletcher III | Art Unit 1762 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see the response filed 11/26/2003, with respect to the objections to the spec./claim and the rejections under 35 U.S.C. § 112, 2nd Para., have been fully considered and are persuasive in view of applicants amendments. These objections and rejections have been withdrawn.

2. Applicant's arguments filed 11/26/2003, with respect to the prior art rejections, have been fully considered but they are not persuasive.

Initially, applicant argues that Sheets teaches the press-coating of a primer-coated overlay paper to the wooden substrate, while applicant's method does not involve an overlay paper. The examiner notes that the claims merely recite "applying a press coating to the substrate" and do not exclude the use/presence of an overlay paper. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Consequently, this argument is not commensurate in scope with the claims and is not persuasive.

Additionally, applicant argues that Sheets requires a comparatively greater number of process steps than the claimed method. The examiner notes that the claims recite the transitional phrase "comprising." This transitional phrase is inclusive or open-ended and does not exclude additional, un-recited elements or method steps (see MPEP § 2111.03). Consequently, this argument is not commensurate in scope with the claims and is not persuasive.

Lastly, applicant argues that Sheets and Cooley, because they involve an overlay paper, are not analogous to applicant's invention. It has been held that a prior art reference must either

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be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). By applicant's own admission in the response filed 11/26/2003, the cited references and applicant are all concerned with providing smooth press coatings on wooden substrates in order to prevent excessive paint absorption. Consequently, the particular problem is the same in all cases. As noted above, the claims merely recite "applying a press coating to the substrate" and do not exclude the use/presence of an overlay paper. Consequently, this argument is not persuasive.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 1 – 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets (US 5,059,264).**

Sheets teaches a method in which a press coating is applied to a wooden substrate, such as hardboard or waferboard [abstract and c. 1, ll. 1 – 48]. The press coating is an aqueous dispersion comprising emulsion polymerized ethylenically unsaturated monomers, filler, and/or pigment [c. 3, ll. 3 – 37; c. 4, ll. 54 – 64; and c. 5, ll. 3 – 21]. Heat and pressure is applied to the press coating-coated substrate to cure the press coating and give a smooth surface [c. 5, ll. 22 – 40 and c. 1, ll. 61 – 65]. Sheets does not explicitly state, in the body of the reference, that a top coat is applied after curing of the press coat, said top coat being subsequently cured; or that a primer coat is applied and cured prior to application of the top coat. Sheets does teach that “Prefinished hardboard is made by consolidating lignocellulosic fibers under pressure in a press followed by application of one or more primer coats or top coats” [c. 1, ll. 20 – 23]. Based on this teaching, it would have been obvious to one of ordinary skill in the art to modify the process of Sheets so as to coat and cure, atop the cured press coat, one or more primer coats and top coats. One of ordinary skill in the art would have been motivated to do so by the teaching of Sheets that doing so is a conventional means of yielding a prefinished wooden substrate suitable for a given end-use.

The examiner notes that Sheets is silent with respect to the degree of compression of the wooden substrate. Curing of the press coat is performed at 400°F and 300-500psi [c. 5, l. 30]. These values fall within the temperature and pressure ranges disclosed by applicant at p. 5, ll. 4 – 9 of the spec. Since Sheets otherwise teaches all of applicant’s claimed press coating steps, it is

the examiner's position that, unless some critical limitation(s) is/are not recited, the curing step of Sheets does not substantially compress the substrate, as defined at p. 3, ll. 17 – 24 of the spec.

With respect to claim 3, Sheets is silent with respect to exactly what sort of production apparatus is utilized. Absent clear and convincing evidence or arguments to the contrary, it is the examiner's position that performing all of the coating steps in a single production line would have been obvious to one of ordinary skill in the art in order to achieve maximum automation and efficiency of the coating process.

With respect claim 6, while Sheets does express the amount of pigment and/or filler in terms of "pigment-volume-content (PVC)," and that the PVC is between about 30% and 65%, the reference is silent with respect to the amount based on the total weight of the emulsion solids [c. 5, ll. 18 – 21]. It is the examiner's position that, since Sheets teaches adjusting the amount of pigment and filler, and since the amounts of these components are well-known result-effective variables effecting the viscosity and color of the coating, it would have been obvious to one of ordinary skill in the art to optimize these result-effective variables by routine experimentation. See MPEP § 2144.05(II)(A) and (B).

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheets (US 5,059,264) as applied to claim 1 above, and further in view of Cooley (US 4,587,141).

The teaching of Sheets is detailed above. With respect to claim 4, Sheets does not teach that the trop coat is a radiation-curable top coat, cured by UV radiation. With respect to claim 5, Sheets does not teach that, before the top coat is applied, the substrate is printed. The examiner has interpreted this limitation as being inclusive of both the pre- and post-press coated substrate.

With respect to claim 4, Cooley, like Sheets, teaches a wooden substrate that has been previously coated with a resin and overlay paper [c. 3, l. 45 – c. 6, l. 6]. According to Cooley, the overlay paper receives a top coat of UV-curable resin that is subsequently UV cured [c. 5, ll. 33 – 46]. The UV-cured resin coating protects the underlying substrate [c. 5, ll. 56 – 58]. It would have been obvious to one of ordinary skill in the art to modify the process of Sheets so as to coat, as the top coat, a UV-curable resins, as taught by Cooley. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully protecting the underlying substrate, as suggested by Cooley.

With respect to claim 5, Cooley teaches that the overlay paper may be printed with a decorative design to make the finished product suitable for use in structural applications [c. 4, ll. 16 – 50 and c. 1, ll. 1 – 10]. Consequently, it would have been obvious to one of ordinary skill in the art to modify the process of Sheets so as to utilize, as the overlay paper, a paper printed with a design, as taught by Cooley. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully imparting decorative effects to the finished wooden product, suitable for structural applications, as taught by Cooley.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

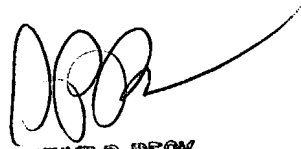
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (571) 272-1419. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

WPF 1/23/2004

William P. Fletcher III
Examiner
Art Unit 1762


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700